

REMARKS

I. Oath and Declaration

A new Oath and Declaration comprising all required information in compliance with MPEP §§ 602.01 and 602.02 is submitted herewith.

II. Claim Amendments

Claims 1-6 and 8-10 have been amended. Claim 7 has been canceled. The amendments to Claims 1-6 and 8-10 have been introduced to improve claim form, including to correct much regretted typographical errors, and in response to the Examiner's objections set forth at page 2 of the Office Action. None of the amendments introduces new subject matter as support may be found in the application as filed.

II. Amended Claims 1-6 are patentable over Jacoby

Original claims 1-6 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Jacoby (U.S. Patent No. 5,328,365). Applicant respectfully submits that amended claims 1-6 are not anticipated by Jacoby for the following reasons.

Amended claims 1-6 are directed to dental instruments characterized in that they are suitable to treat a surgical site simultaneously (a) cutting, scraping and/or grinding, as well as (b) trimming and cauterizing to remove diseased tissue and to destroy residual bacteria. The latter aspect is achieved by the use of laser energy in the low infrared spectrum approximately from 600 nm to 1100 nm.

Jacoby does not teach or suggest the use of laser energy in the low infrared spectrum approximately from 600 nm to 1100 nm. Accordingly, because the devices described by Jacoby do not have all of the elements contained in the amended claims it may not anticipate claims 1-6 as amended (Nystrom v. Trex Co., F.3d 1105 (Fed. Cir. 2004)).

Withdrawal of the rejections on the record and reconsideration of the amended claims are kindly requested in light of the foregoing remarks.

III. Amended Claims 8-10 are patentable over Jacoby in view of Alexander

Claims 7-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jacoby in view of Alexander (U.S. Patent No. 6,561,802). Claim 7 has been canceled rendering its rejection moot. Claims 8-10 have been amended.

As set forth by Applicant in pertinent parts of paragraph [0029] of the published application (Pub. No. US 2004/0202982) the invention capitalizes on the discovery that

“[the] infrared optical energy delivered through the scaler exits under the blade of the scaler through a [...] window [...] bathes the periodontal tissues in the pocket at the time of the mechanical debridement [...] to promote selective bacterial death.”

As discussed *supra*, Jacoby does not teach or suggest an instrument or a method of use of an instrument emitting laser energy in the low infrared spectrum approximately from 600 nm to 1100 nm to (1) cut, scrape and/or grind, and (2) trim and cauterize, to remove diseased tissue and to destroy residual bacteria in a surgical site. Alexander merely purports to teach a diagnostic tool which is said to be suitable to identify caries, plaque, bacterial infection, concretions, tartar and other fluorescent substances on teeth. Alexander is not seeking to cut, scrape and grind while destroying bacteria. At best Alexander may be said to seek to visualize plaque and bacterial infection. Alexander does not teach the use of laser energy in the low infrared spectrum approximately from 600 nm to 1100 nm according to the instant invention. Alexander thus, fails to cure the deficiencies of Jacoby.

Because Jacoby in view of Alexander do not suggest the invention set forth in amended claims 8-10, Applicant respectfully requests withdrawal of the rejections on the record and reconsideration of the amended claims.

CONCLUSION

In light of the amendments and remarks herein, Applicant submits that the claims are now in condition for allowance and respectfully requests a notice to this effect. The Examiner is invited to contact the undersigned to expedite prosecution.

U.S Serial Number 10/723,031

Amendment Pursuant 37 C.F.R. § 1.111

April 6, 2006

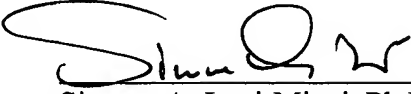
Page 7 of 8

A Request for a Three (3) Month Extension of Time, up to and including April 6, 2006, is included herewith. Pursuant to 37 C.F.R. § 1.136(a)(2), the Examiner is authorized to charge any fee under 37 C.F.R. § 1.17 applicable in this instant, as well as in future communications, to Deposit Account 50-1133.

[Cont'ed on the next page]

Furthermore, such authorization should be treated in any concurrent or future reply requiring a petition for an extension of time under § 1.136 for its timely submission, as constructively incorporating a petition for extension of time for the appropriate length of time pursuant 37 C.F.R. § 1.136(a)(3) regardless of whether a separate petition is included.

Respectfully submitted,
MCDERMOTT WILL & EMERY LLP



Simona A. Levi-Minzi, Ph.D.
Registration No. 43,750
Attorney for Applicant

McDermott Will & Emery LLP
28 State Street
34th Floor
Boston, MA 02109-4000
Tel.: 617.535.4049
Fax: 617.535.3800

Date: April 6, 2006